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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL VAN NGUYEN

Appeal 2009-007175
Application 10/696,610
Technology Center 2100

Decided: September 21, 2009

Before JEAN R. HOMERE, THU A. DANG, and STEPHEN C. SIU,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals the Examiner's final rejection of claims 1 and 3-10 under 35 U.S.C. § 134(a) (2002). Claim 2 is canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We affirm-in-part and enter a new ground of rejection in accordance with 37 C.F.R. § 41.50(b).

A. INVENTION

According to Appellant, the invention relates to a pen-based computer providing a designated button that facilitates mode selection, by simple actuation or non-actuation, such that “the stylus or pen need not be lifted from the display screen to access panning or scroll sub routines during writing, drawing, editing or the like” (Spec. 31).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and reproduced below:

1. A pen-based computer interface system comprising:

a pen-based computer having a touch sensitive display screen, at least one input button, a stylus pen and a memory based processor having a stored operating system therein;

means for causing said processor to operate in a write mode characterized by displaying the movement path of said pen upon said display screen;

means for causing said processor to operate in a pan mode characterized by the movement of said movement path within said display screen in response to pen contact with and movement upon said display screen;

means for operating said processor in either said write mode or said pan mode; and

a single button for controlling said means for operating to allow a user to select said write mode or said pan mode.

C. REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Keely

U.S. 6,337,698

Jan. 8, 2002

Claims 1 and 3-10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Keely.

II. ISSUES

1) Has Appellant shown that the Examiner erred in finding that Keely discloses a “means for operating said processor in either said write mode or said pan mode; and a single button for controlling said means for operating to allow a user to select said write mode or said pan mode” (claim 1)?

2) Has Appellant shown that the Examiner erred in finding that Keely discloses “writing in response to said button being non activated” and “panning in response to said button being activated” (claim 5)?

3) Has Appellant shown that the Examiner erred in finding that Keely discloses “writing in response to said button being activated” and “panning in response to said button being non activated” (claim 8)?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Keely

1) Keely discloses a notepad computer with a page display that a user can write on using a stylus (“pen”) (Abstract).

2) A “scroll shadow” appears when a document is larger than the page display, such as when a spreadsheet is displayed or a page is magnified (col. 10, ll. 28-31).

3) Bringing a pen onto the scroll shadow causes respective scrolling, i.e., left, right, upper, and lower scroll shadows cause left, right, upper, and lower scrolling (col. 10, ll. 1-32).

*Duke*¹

4) Duke discloses a mouse button that is pressed to lock a mouse pointer at a position of graphic data on a display screen (col. 5, ll. 1-9).

5) By moving the locked pointer, the user pans the graphic data across the display screen (col. 5, ll. 9-20).

IV. PRINCIPLES OF LAW

Claim Interpretation

The claims measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm.*

¹ Relied upon in new ground of rejection infra.

Corp., 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999). “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” *Id.* (citations omitted).

35 U.S.C. § 103(a)

Section 103(a) forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417. The Court explained that:

When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a

predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability.

Id. at 401.

In affirming a determination of obviousness, the Federal Circuit has relied, in part, on an applicant's failure to present evidence that the proposed combination of teachings was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418-19).

V. ANALYSIS

Claims 1, 3, 4, 6, 7, 9, and 10

With respect to independent claim 1, Appellant argues that Keely is "not suited for operation in a handheld personal digital assistant or PDA type device" (Br. 7). According to Appellant, the "problem which arises in systems such as Keely is that during the writing process the user upon encountering an edge of the display or otherwise desiring to move or pan the written image must completely stop the writing process . . . to move the stylus from the point of writing to . . . tap the desired icon with the pen in order to switch from the write mode to the pan mode" (App. Br. 7; Board's emphasis). Appellant further states that in Appellant's invention, by contrast, "the user, while maintaining the pen position on the written material, simply presses the mode switch button (switching to pan mode)" (Br. 8; Board's emphasis). Appellant asserts that, in view of these differences, a "manually actuated button and a screen pen touch icon selection element are simply not the same nor are they equivalent in the

environment which the present invention is directed” (*Id.*; Appellant’s emphasis).

The Examiner responds that “the features upon which applicant relies (i.e., operation in a handheld personal digital assistant or PDA type device and system that is carried forward with virtually no interruption of the writing process and without the need to move the pen from the writing image) are not recited in the rejected claim(s)” (Ans. 7). The Examiner also responds that claim 1 does not recite whether “the button is physical or not (a part of the user interface) [and] therefore it is evident that Keely meets the claim limitations” (Ans. 9).

Accordingly, an issue we address on appeal is whether Keely teaches “means for operating said processor in either said write mode or said pan mode; and a single button for controlling said means for operating to allow a user to select said write mode or said pan mode” (claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns*, 988 F.2d at 1184.

Contrary to Appellant’s arguments (Br. 6 and 8), claim 1 does not limit its pen-based computer interface system to a “PDA-type device” or to a structure that allows switching between write and pan modes while “maintaining the pen position on the written material.” Thus, we will not interpret claim 1 as requiring these features.

Further, claim 1 does not limit its “button” to a hardware-type button as Appellant argues (Br. 8). Rather, claim 1 merely recites “a single button” that allows a user to “select said write mode or said pan mode.” Thus, we

interpret the “button” of claim 1 as including both hardware-type and screen icon-type buttons.

We note that the “panning” of claim 1 reads on scrolling. We interpret “panning” as doing so because, by Appellant’s admission, “[i]n the prior art, the switch from write mode to pan mode is accomplished by pen stylus contact with screen icons or scroll bars” (Br. 6; Board’s emphasis).

Keely discloses a notepad computer with a page display that a user can write on using a stylus (“pen”) (FF 1). A scroll shadow icon appears when a document is larger than the page display, such as when a spreadsheet is displayed or a page is magnified (FF 2). Bringing a pen onto a scroll shadow selects the scrolling and writing modes, respectively (FF 3).

An ordinarily skilled artisan would have understood Keely’s writing and scrolling modes as teaching the “means for operating said processor in either said write mode or said pan mode” (claim 1). The skilled artisan would also have understood Keely’s scroll shadow as disclosing “a single button for controlling said means for operating to allow a user to select said write mode or said pan mode” (claim 1) because the scroll shadow controls selection between the writing and scrolling modes.²

Accordingly, Appellant has not shown the Examiner erred in rejecting claim 1, and dependent claims 3, 4, 6, 7, 9, and 10 falling therewith, under 35 U.S.C. § 102(b) as being anticipated by Keely.

² We note that the “single button” of claim 1 also reads on a button that merely selects either a write mode or pan mode, i.e., not necessarily both.

Claim 5

Appellant states that the arguments for patentability of claim 1 apply “with equal force” to claim 5 (Br. 10 and 12). For the reasons set forth above, we find this argument unpersuasive.

Claim 5 recites “writing in response to said button being non activated” and “panning in response to said button being activated” (Board’s emphasis). Appellant argues that, by contrast, “Keely simply does not provide this preferential assignment of activation or non-activation of the screen icon touch-based system which Keely employs” (Br. 11).

Claim 5 does not define what the term “activated” is to be, to represent or to mean, other than that panning is performed in response to the button being “activated.” We give “activated” its broadest reasonable interpretation to mean performing an assigned function and “non-activated” to mean not performing the assigned function.

As noted with respect to claim 1, Keely’s scroll shadow causes the display screen to scroll while a pen is held on the scroll shadow (FF 2-3). We therefore find that Keely’s device pans when the scroll shadow is “activated” by being pressed; and writes when the scroll shadow is “non activated” by being released. Thus, a skilled artisan would have understood Keely’s scroll shadow as “panning in response to said button being activated” and as “writing in response to said button being non activated” (claim 5).

Accordingly, we affirm the rejection of claim 5 as being anticipated by Keely under 35 U.S.C. § 102(b).

Claim 8

Claim 8 conversely recites “writing in response to said button being activated” and “panning in response to said button being non activated” (Board’s emphasis). Appellant presents a similar argument for claim 8 as claim 5 above, stating that “[i]n essence, the subject matter of claim 8 is directed to the reverse of the system in claim 5” (Br. 12).

As discussed above, we interpret “activated” to mean performing an assigned function and “non-activated” to mean not performing the assigned function. Since Keely’s scroll shadow could not be activated (e.g., remain pressed by the pen) during a writing operation, the skilled artisan would not have understood Keely’s scroll shadow as “writing in response to said button being activated” and “panning in response to said button being non activated” as required by claim 8.

Accordingly, we reverse the rejection of claim 8 as being anticipated by Keely under 35 U.S.C. § 102(b).

VI. NEW GROUND OF REJECTION

35 U.S.C. § 103(a)

Claim 8

As a new ground of rejection, we reject claim 8 under 35 U.S.C. § 103(a) because we find no patentable distinction between the devices of claim 8 and Keely in view of Appellant’s admitted prior art. More particularly, we find that claim 8 is unpatentable over Keely in view of U.S. Patent No. 6,407,749 to Duke (hereinafter “Duke”), which is described by Appellant’s disclosure (Spec. 5, ¶ [0010]).

Duke discloses a mouse button that is pressed to lock a mouse pointer at a position of graphic data (FF 4). By moving the locked pointer, the user pans the graphic data across the display screen (FF 5). We find that Duke discloses a hardware button for toggling between panning and writing operations, where the “writing” corresponds to the editing of the graphic data. It would have been obvious to add this functionality to Keely’s device, such that Duke’s panning feature, which is different than mere scrolling, could be added.

Duke does not write in response to the mouse button’s activation, as required by claim 8. However, Appellant admits that the choice to write in response to activation (e.g., pressing) or non-activation (e.g., releasing) of a hardware button is an obvious choice based on user preferences (Br. 11-12). More particularly, Appellant admits that claims 5 and 8 are identical, with the exception that claim 5 implements panning in response to button activation (e.g., pressing) because sometimes the panning mode is used less extensively than the write mode (Br. 11). Conversely, claim 8 implements writing in response to button activation because sometimes the write mode is used less extensively than pan mode (Br. 12).

Thus, we find that the difference between the hardware buttons of Duke and claim 8, i.e., writing/panning in response to button activation/deactivation, is prompted by an incentive to better accommodate either the pan mode or write mode. We further find that an ordinarily skilled artisan could easily implement and recognize the benefit of this variation. In view of *KSR*, we conclude that such a variation does not render claim 8 patentable. *See* 550 U.S. at 401.

There are no facts in the appellate record to suggest that either the addition of Duke's writing/panning function to Keely's device or the proposed modification of that function (i.e., to implement writing in response to button activation, as recited by claim 8) would be "uniquely challenging or difficult for one of ordinary skill in the art," *Leapfrog*, 485 F.3d at 1162, or "more than the predictable use of prior art elements according to their established functions," *KSR*, 550 U.S. at 417.

For the foregoing reasons, claim 8 fails to recite a patentable distinction over Keely in view of Duke under 35 U.S.C. § 103(a).

VI. CONCLUSIONS

Appellant has not shown the Examiner erred in finding claims 1, 3-7, 9, and 10 are anticipated by Keely under 35 U.S.C. § 102(b).

Appellant has shown the Examiner erred in finding claim 8 is anticipated by Keely under 35 U.S.C. § 102(b).

Claim 8 is not patentable over Keely in view of Duke under 35 U.S.C. § 103(a).

VII. DECISIONS

We affirm the Examiner's decision rejecting claims 1, 3-7, 9, and 10 under 35 U.S.C. § 102(b). However, we reverse the Examiner's decision rejecting claim 8 under 35 U.S.C. § 102(b) but enter a new ground of rejection of claim 8 under 35 U.S.C. § 103(a).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). That section provides that "[a] new ground of rejection ... shall not be considered final for judicial review."

Section 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. ...

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART -- 37 C.F.R. § 41.50(b)

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